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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,904	10/14/2003	Peter M. Bonutti	780-A03-012B	3567

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MIAMI, FL 33180

EXAMINER

HOFFMAN, MARY C

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/684,904	Applicant(s) BONUTTI, PETER M.	
	Examiner Mary Hoffman	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 47-50 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-46 is/are allowed.
- 6) ☒ Claim(s) 1,4-9,13-15,18,22,24,28,29 is/are rejected.
- 7) ☒ Claim(s) 2,3,10-12,16,17,19-21,23,25-27 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) ☒ Information Disclosure Statement(s) (PTO/SB/08) | 5) ☐ Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/14/2003</u> | 6) ☐ Other: _____ |

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-46, in the reply filed on 10/02/2006 is acknowledged. The traversal is on the ground(s) that the example provided by the examiner as to why the groups are distinct is incorrect because the apparatus claims recite the language "for cutting the inner side of a patella". This is not found persuasive because the language "for cutting the inner side of a patella" in the apparatus claims 47-50 is being recited functionally, and therefore, the device claims 47-50 need only be capable of cutting the inner side of a patella, or having an arm positionable under the patella, i.e. capable of being positioned, under the patella. It is possible that a cutting device could be capable of cutting the inner side of a patella, or having an arm positionable, but not intended for that particular use of the claimed methods.

Claims 47-50 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/02/2006.

The requirement is still deemed proper and is therefore made FINAL.

Specification

The disclosure is objected to because of the following informalities:

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On page 1 of the specification, line 12, it appears that the text should read -- March 1, 2001--, rather than the currently recited "March 1, 2000".

On page 2 of the specification there are multiple typos present in the heading, "Background of the Invention".

Appropriate correction is required.

Information Disclosure Statement

The information disclosure statement filed 10/14/2003 has been placed in the application file, but some of the information referred to therein (the Non-Patent Literature listed on sheets 6-7) has not been considered as to the merits because the examiner does not know the location of this NPL. It is assumed that Applicant has already submitted the NPL in one of the many previous, older paper-file parent applications; however, these paper-files have not been scanned into the electronic IFW system and will need to be ordered. Due to the numerous quantities of parent applications, the examiner is requesting that Applicant specify which parent cases contained the aforementioned NPL so that the appropriate paper files can be efficiently ordered and reviewed.

Claim Objections

Claim 24 is objected to because of the following informalities: In claim 24, lines 3, "to defining" should be changed to --to define-- to be grammatically correct.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-9, 13-15, 18, 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Stein (U.S. Patent No. 5,571,196).

Stein discloses a method of performing surgery on a leg of a patient comprising making an incision in a knee portion of the leg (FIG. 1), displacing a patella in the knee portion of the leg from a normal position to an offset position with an inner side of the patella facing inward (FIG. 1); and positioning a cutting tool proximal to at least one of an upper or a lower portion of the leg (FIG. 7). The method further comprises cutting an end surface of at least one of the upper or lower portions of the leg. The method further comprises moving at least one implant through the incision while the patella is offset from the normal position with the inner side of the patella facing inward (FIG. 12); and (indirectly) connecting the at least one implant with the cut end portion of at least one of the upper or lower portions of the leg (FIG. 12). The method includes connecting a guide member to at least one of the upper or lower portions of the leg (FIG.9). The guide member is connected to the upper portion of the leg, the upper portion being a femur, the guide member including a first end portion in engagement with a lateral condyle of the femur, the first end portion offset medially from a lateral edge portion of

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the lateral condyle, and a second end portion in engagement with a medial condyle of the femur, the second end portion offset laterally from a medial edge portion of the medial condyle (FIG. 9, see opposed slots on ref. #90). The method further comprises cutting the lateral and medial condyle of the femur (FIG. 9). The method further comprises moving at least one femoral implant (ref. #30) through the incision while the patella is offset from the normal position with inner side of the patella facing inward (see detached patella of FIG. 1); and connecting the at least one femoral implant with the cut lateral and medial condyle of the femur (FIG. 10). The method further comprises moving a guide member (FIG. 9) into the incision, the guide member including opposite ends spaced apart by a distance that is less than a distance between a lateral epicondyle and a medial epicondyle on a femur; positioning the guide member on the femur in the leg of the patient with the opposite ends of the guide member aligned with an axis through the lateral and medial epicondyles; positioning the cutting tool (ref. #92) on the guide member; and moving the cutting tool along a guide surface on the guide member to cut the lateral and medial epicondyles on the femur. The method further comprises cutting the inner side of the patella in the knee portion of the leg (FIG. 2), wherein the inner side of the patella faces towards a posterior portion of the knee portion of the leg and includes removing at least a portion of the inner side of the patella (being interpreted as non-simultaneous). The method further comprises moving at least one patella implant through the incision; and connecting the at least one patella implant to the cut inner side of the patella. The method further comprises supporting the patient with the lower portion of the leg suspended from the upper portion of the leg, wherein the lower portion

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remains suspended from the upper portion while the incision is made in the knee portion of the leg and the patella is moved to the offset position with the inner side of the patella facing inward (FIG. 1). The method further comprises initiating a cut with the cutting tool along an end portion of at least one of the upper or lower portions of the leg to define a cutting surface (FIG. 7-8); and completing the cut while guiding the cutting tool along the cutting surface formed during making of the initial cut in an end portion of at least one of the upper or lower portions of the leg (FIG. 9-10). The method includes making the incision in the knee portion adjacent to a medial edge portion of the patella.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stein (U.S. Patent No. 5,571,196).

Stein discloses the claimed method except for the incision having a length between about seven and thirteen centimeters. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make an incision of Stein between the length of seven to thirteen centimeters, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the

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optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stein (U.S. Patent No. 5,571,196) in view of Vukovic (U.S. Patent No. 4,369,768).

Stein discloses the claimed method except for moving a leading end of an endoscope through the incision to view the knee.

Vukovic discloses moving a leading end of an endoscope through the incision to view the knee to minimize the risks associated with knee surgery (col. 1, lines 24-26).

It would have been obvious to one having ordinary skill in the art at the time the invention was made perform the method of Stein including moving a leading end of an endoscope through the incision to view the knee in view of Vukovic to minimize the risks associated with knee surgery.

Allowable Subject Matter

Claims 2-3, 10-12, 16, 17, 19-21, 23, 25-27 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 31-46 are allowed.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER